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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,792	01/15/2002	W Thomas Urmson, Jr.	2046-011632	7034

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EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
3682	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,792

Applicant(s)

URMSON, JR. ET AL.

Examiner

Timothy P McAnulty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-17, 19-22, 28 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 14, 17, 19-22, 28 and 33-37 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/19/04, 8/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite because it does not further limit claim 15 from which it depends.

The limitations of claim 19 are broader than the limitations of claim 15.

Claim 22 is indefinite because it depends from claim 13, which is cancelled. For the purposes of this Office action, claim 22 is being considered dependent on claim 14.

The recitation of "said distribution blade" in line 2 of claim 22 lacks antecedent basis.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 14,17, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Huck.

Huck discloses in figure 1, a wayside top of rail applicator system comprising a rail 9 having a head 11 having an upper surface with a crown; an applicator for applying a material on the upper surface of said head having a body, a flow passageway 55 defined in said body for the material to flow therethrough, said flow passageway having an exit for directing the material to said crown, a neoprene skirt 56 positioned adjacent the exit and above the crown, and a distribution blade 57.

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5. Claims 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Watts.

Watts discloses in figures 1-3, a wayside top of rail applicator system comprising a rail 7 having a head 12; an applicator for applying a material to said head having a body 3 having a flow passageway therein, said flow passageway defining a stationary end 5, a rubber member 17 forming a portion of the stationary end adapted to contain the material for depositing on an outside surface of said head.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 28 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huck.

Huck discloses the basic apparatus as set forth above but does not disclose said skirt being a rubber material reinforced with fibers or being metal. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide said skirt being either a rubber material reinforced with fibers or being metal, since it has been held to be within the skill of one of ordinary skill in the art to select a known material on the basis of its suitability for the intended use as a matter of engineering design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

8. Claims 1-8 are allowed.

The newly submitted reference GB 718,398 discloses a wasyside applicator for applying material to the upper surface of a head of a rail comprising a flow passageway defined in a body, said flow passageway defining an exit end; and a dam provided adjacent the exit end containing material with an outside upper surface of the head of the rail but does not disclose said dam

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terminating at a crown of the head of the rail. On the contrary, GB 718,398 discloses a dam terminating at a far side of said upper surface of the head of the rail, i.e., material is contained on the entire upper surface of the rail (so as to lubricate wheel flange 85). One of ordinary skill in the art would not be motivated to modify the apparatus of GB 718,398 to have the dam terminate at the crown of the head of the rail because doing so would reduce the effectiveness of providing lubricant to the wheel flange which does not travel on the rail head but only travels adjacent the rail head (rail 17 is a check rail to provide support and reduce derailment of a wheel traveling on rail 16).

9. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art discloses the basic apparatus as set forth above but does not disclose said material contained on an upper surface of the rail, i.e., the dam creates a reservoir of material atop the rail.

10. Claims 19-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments with respect to claims 14,17,22, and 33-37 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claims 14,17,22, and 37, the limitations therein merely require the flow passageway to *direct* material to the crown of a rail. The claims do not limit the material to be

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contained on an upper surface of the crown. Accordingly, the apparatus disclosed by Huck meets the claims.

Regarding claims 33-36, the limitations therein merely require the elastomeric member to contain material on an *outside surface* of the head. The claims do not limit the material to be contained on an upper surface of the crown. Accordingly, the apparatus disclosed in Watts meets the claims.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tpm



10/18/09
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